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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,913	11/27/2000	Paul Stephen Tolley	15-810	3648

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EXAMINER

HAMILTON, LALITA M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/722,913

Applicant(s)

TOLLEY, PAUL STEPHEN

Examiner

Lalita M Hamilton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: The specification does not contain a brief description of the drawings.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-5 and 14 recite the limitation "purchasing member" in claim 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 is rejected for its dependency upon claim 11.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4-13 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 95/34161.

WO 95/34161 discloses a prepaid card comprising:

- a payment system (**p.2, lines 20-25 and p.6, lines 24-35**), the payment system comprising a plurality of purchasing unit means which can be issued and have a predetermined value or values (**p.2, lines 20-30**), activating means operable when a purchasing unit means is issued (**p.2, lines 25-35**), means for checking the activating means to establish

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whether a purchasing unit means has been issued **p.3, lines 5-15**), and means for cancelling part or all of the issuance when part or all of the purchasing unit means is spent **p.10, lines 30-36**)

- the purchasing unit means provided electronically (**p.6, lines 19-34**)
- the purchasing member comprises a physical member (**p.6, lines 19-34**)
- the purchasing member comprises a card (**p.6, lines 19-34**)
- the purchasing unit means includes a visually readable unique identification (**p.6, lines 25-30**)
- the purchasing unit means comprises a machine readable unique identification (**p.6, lines 25-38**)
- the machine readable identification is in the form of a magnetic strip and barcode (**p.6, lines 25-38 and p.8, lines 15-16**)
- purchasing unit means with different predetermined values are provided (*pre-paid card*) (**p.8, lines 1-12**)
- means provided to permit a purchaser of a purchasing unit means to allocate a unique security code to the purchasing unit means, which security code is required to be given to enable the purchasing unit means to be spent (*voice recognition may be unique code*) **p.8, lines 20-26 and p.9, lines 17-23**)
- the physical member comprises a detachable part, which part bears a unique security code (*scratch-off portion*) (**p.6, lines 19-34**)
- the activating means comprises an accessible database which records the unique identifications of the purchasing unit means and an indication as to whether the purchasing unit means have been issued and whether the issuance has yet been cancelled (**p.3, lines 5-15; p.8, lines 20-26; and p.9, lines 17-23**)
- the activating means comprises a plurality of discrete vending stations where purchasing unit means can be purchased or otherwise distributed, and simultaneously issued, with a signal being sent to the database that the particular purchasing unit means has been issued (**p.6, lines 20-22; p.8, line 32 to p.9, line 5; and fig.1: 14**)
- apparatus usable in a purchasing system (**p.2, lines 20-25**)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/34161 in view of Tasket (5,988,509).

WO 95/34161 discloses the invention substantially as claimed; however, WO 95/34161 does not disclose:

- the purchasing unit means are such that a purchaser can print the purchasing unit means
- the canceling means comprises a plurality of discrete purchasing stations where the identification of purchasing unit means can be read or inputted, and a signal sent to the database to cancel part or all of the issuance of the purchasing member
- the means are provided to permit the non-canceled values of two or more purchasing unit means to be combined on a fresh purchasing unit means

Tasket teaches a pre-paid telephone card comprising:

- the purchasing unit means are such that a purchaser can print the purchasing unit means (**col.7, lines 1-18**)
- the canceling means comprises a plurality of discrete purchasing stations where the identification of purchasing unit means can be read or inputted, and a signal sent to the database to cancel part or all of the issuance of the purchasing member (**col.8, lines 14-35**)

It is inherent that the consumer may have the option of combining the values of two or more purchasing unit means as long as the consumer keeps the replacement codes for all cards (**col.8, lines 14-35**). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a purchasing unit means that may be printed or to allow the purchasing unit to be canceled, as taught by Tasket into the device and method disclosed by WO 95/34161, as an alternative form of the card and to allow the user to cancel the card and receive a refund.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M Hamilton whose telephone number is (703) 306-5715. The examiner can normally be reached on Tuesday-Thursday (8:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-2272.


LMH

VINCENT MILLIN
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